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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,700	09/14/2001	Margo Gisselberg	34114.8005US	8619
25096	7590	01/10/2006	EXAMINER	
PERKINS COIE LLP			LEE, BENJAMIN C	
PATENT-SEA				
P.O. BOX 1247			ART UNIT	
SEATTLE, WA 98111-1247			2632	
			PAPER NUMBER	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/954,700

Applicant(s)

GISSELBERG ET AL.

Examiner

Benjamin C. Lee

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 04 October 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 103(a) rejection of claim 26.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 26.

Claim(s) objected to: _____.

Claim(s) rejected: 1-22, 24 and 25.

Claim(s) withdrawn from consideration: 23 and 27.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

X See Attachment

Benjamin C. Lee
Benjamin C. Lee
Primary Examiner
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Attachment to Advisory Action

Response to Arguments

1. Applicant's arguments filed 1/4/05 have been fully considered but they are not persuasive.

A) Regarding the 35 USC 102(b) rejection of claim 24 over Hansen, the previous Office action "Response to Arguments" section already addressed applicant's arguments. Additionally, the phrase "resonating marker assembly" of the claim preamble constitutes a nominal designation for the claimed device which is met by Hansen. Even if "resonating marker" were to be better defined in the claim, it would have still constituted an intended use of the claimed invention under 35 USC 102(b) anticipation rejection since all claimed limitations and features are met by Hansen, including the claimed "axially adjustable segment at the second end of the core" which is met by axially adjustable segment of rod/core 11 at end 12 of Hansen, since claim 24 does not require that the "segment" be separate from the core or that it can not be a segment of the core.

B) Regarding the 35USC 103(a) rejection of claims 1-3 and 12 over Zimmermann, the previous Office action "Response to Arguments" section already addressed applicant's arguments. Additionally, the argued "markers used in human patients" is not persuasive since such limitation/feature is not claimed. Furthermore, the claimed "miniaturization" feature does not specify the degree of miniaturization or the how small the device is or needs to be, so that one skilled in the art would have implemented a small or smaller sized marker device of Zimmermann based on various factors and preferences. Similarly, the argued "claimed size of the marker assembly" is not persuasive since it establishes no specific standard to which one can

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compare it with. The argued “biocompatible body” is not found in claim 1. Fig. 1b of Zimmermann does show marker device 1 having a geometric center coincident with its magnetic center. Furthermore, it is noted that geometric center and magnetic center may be interpreted as the longitudinal central axis (i.e. “center” interpreted as the “core” or “center line” of an object, not necessarily the “center single point” of an object) of the coil/core through which the magnetic flux passes inside the central portion the coil/core as confined by the coil, in which the two centers are coincident, since the claimed invention does not distinguish the two.

C) Arguments regarding the rejection of claims 4-9 and 15-18 are based on the arguments presented for claim 1 above, and thus are rebutted as in the response to arguments of claim 1 indicated above and the Final rejection of claims 4-9 and 15-18 (rejection of claim 17 indicated that Taylor and Mejia in the reference combination teaches the intended use and miniaturization of the marker device for implant in living creatures which includes tissue).

D) Arguments regarding the rejection of 10-11 are based on the arguments presented for claim 1 above, and thus are rebutted as in the response to arguments of claim 1 indicated above and the Final rejection of claims 10-11.

E) Arguments regarding the rejection of 13-14 are based on the arguments presented for claim 1 above, and thus are rebutted as in the response to arguments of claim 1 indicated above and the Final rejection of claims 13-14.

F) Regarding the 35USC 103(a) rejection of claim 20 over Mejia, the previous Office action “Response to Arguments” section already addressed applicant’s arguments. Additionally, Figs. 1-3 and 8-10 of Mejia clearly shows that core 12 on the right hand side differs from the left hand side and therefore the core is substantially symmetrical about the longitudinal axis of the

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core as the coil surrounds the core, while being asymmetrical about a lateral axis of the core since the right hand side as seen on Figs. 1-3 and 8-10 differs geometrically from the left hand side of the core. The claimed coincidence of the magnetic center and the geometric center were rejected as obvious by the examiner. Furthermore, geometric center and magnetic center may be interpreted as the longitudinal central axis (i.e. "center" interpreted as the "core" or "center line" of an object, not necessarily the "center single point" of an object) of the coil/core through which the magnetic flux passes inside the central portion the coil/core as confined by the coil, in which the two centers are coincident. Applicant's arguments appear to be directed to geometric and magnetic "center single point" which has not been specified in the claims.

F') Applicant's arguments regarding ejection of claim 26 appears persuasive, but does not place application in condition for allowance.

G) Regarding the rejection of claim 21, the previous Office action "Response to Arguments" section already addressed applicant's arguments. Additionally, regarding the state of the art as exemplified by Hansen, Hansen shows that the endcap 12 being part of core 11 is moveable reciprocatingly relative to the coil 13 so that coil 13 is of a stiff structure supported only by end 19. While the coil 13 end does not constitute an end of the core 11, it would have been within the skill of one skilled in the art to recognize that an interior supporting structure for the coil having a construction like the reciprocating mechanism of a toilet tissue roll core can be used to implement the same operation/function, which would constitute an obvious structural design alternative rather than an inventive step as indicated in the rejection and examiner's response in the previous Office action. Such reciprocating toilet tissue roll core type structure for the core would have met the claimed structure.

H) Regarding the rejection of claim 22, the previous Office action "Response to Arguments" section already addressed applicant's arguments. Additionally, applicant's arguments that endcaps in Yoakum would interfere with the placement of the transponder in the molding tool or in conflict with its desired arrangement are not persuasive since there are no specific requirements either in the claims or Yoakum as to the size of the endcaps beyond the profile of the device to be molded/encapsulated, so that addition of endcaps for reasons such as physical/structure protection/support for the device would not have interfered or in conflict with Yoakum's objectives. Taylor's endcaps are shown flush with the exterior device profile, which supports the conclusion that such endcaps would not have interfered with molding/encapsulation.

I) Regarding the rejection of claim 19, the previous Office action "Response to Arguments" section already addressed applicant's arguments. Additionally, please refer to section G) above for further discussion of Hansen with respect to the obviousness rejection of claim 19 over Mejia and Hansen.

J) Regarding the rejection of claim 25, the previous Office action "Response to Arguments" section already addressed applicant's arguments. Additionally, since the endcaps in Lemberger and Taylor, as established in the rejection, are there to help positioning the coil over the core, there's no specific requirement for the material and thus the magnetic permeability of the endcaps other than what is desired to establish the effective magnetic permeability as experienced at and by the coil, so that as long as the effect of the magnetic permeability of the endcaps are taken into consideration in the design, endcaps having magnetic permeability different from the central core portion may be chosen without unexpected results.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (571) 272-2963.

The examiner can normally be reached on Mon -Fri 11:00Am-7:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Benjamin C. Lee
Primary Examiner
Art Unit 2632

B.L.